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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/072,641	02/07/2002	Gregory L. Verdine	H00498/70118 TJO/TC	3255

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EXAMINER

MCINTOSH III, TRAVISS C

ART UNIT PAPER NUMBER

1623

DATE MAILED: 01/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/072,641	Applicant(s) VERDINE ET AL.	
	Examiner Traviss C McIntosh	Art Unit 1623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4,5,7 and 31-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4,5,7 and 31-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

In view of the amendment after final filed on September 24, 2004, PROSECUTION IS
HEREBY REOPENED.

The Amendment filed September 24, 2004 has been received, entered into the record, and
carefully considered. The following information provided in the amendment affects the instant
application by:

Claims 1-3, 6, 8-30, and 34-48 are canceled.

Claim 7 has been amended.

Remarks drawn to rejections of Office Action mailed June 25, 2004 include:

112 2nd paragraph rejections: which have been overcome by applicant's amendments and
have been withdrawn.

103(a) rejections: which have been overcome by applicant's amendments and have been
withdrawn.

An action on the merits of claims 4-5, 7, and 31-33 is contained herein below. The text of those
sections of Title 35, US Code which are not included in this action can be found in a prior Office
action.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4-5, 7, and 31-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4 is indefinite wherein the claim is drawn to a method of synthesizing a composition by providing a species comprising a nucleoside and reacting the species with a compound to form a composition comprising the compound in formula 4. Does applicant intend this to be a method of synthesizing a composition, or a method of synthesizing a compound? The claim is drawn to synthesizing a composition, but the language used, i.e. “reacting”, would indicate a method of making a compound, not a composition. Moreover, the claim is indefinite wherein the only active step is “reacting a species with a compound to form a composition”, and one of skill in the art would not know the metes and bounds of the claim, as there is no indication of what the “compound” is to be reacted with the species to form the composition comprising the nucleotide.

Claim 31 is indefinite as the claim is drawn to a method of synthesizing an amine, however, the compound as disclosed is a nucleotide, and not an amine. Changing the preamble to read “a method for synthesizing a compound” or “a method of synthesizing a nucleotide” would be seen to obviate the instant rejection. Moreover, it is additionally unclear if applicants are claiming methods for synthesizing compounds or compositions. The only steps provided in the claim are providing a composition and reacting the NH_2 group of the composition with a compound to form an amine.

The examiner would like to note that if applicants are claiming methods of making compositions, there should be included at least 2 agents in the composition, otherwise, the claim reads as methods of making compounds.

All claims which depend from an indefinite claim are also indefinite. *Ex parte Cordova, 10 U.S.P.Q. 2d 1949, 1952 (P.T.O. Bd. App. 1989).*

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Traviss C McIntosh whose telephone number is 571-272-0657. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

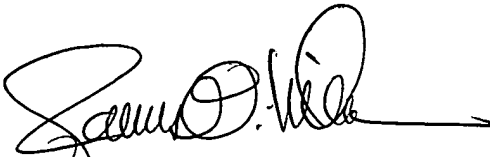
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Traviss C. McIntosh III
December 22, 2004



James O. Wilson
Supervisory Patent Examiner
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